

REMARKS

By this Amendment, Applicant amends claims 1-12. Claims 1-12 are currently pending.

In the Office Action mailed on December 16, 2004, the Examiner rejected claims 1-4 and 7-10 under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,504,995 to Benear et al. (hereinafter "Benear"), and rejected claims 5, 6, 11, and 12 under 35 U.S.C. § 103(a) as unpatentable over Benear in view of U.S. Patent No. 5,708,473 to Mead (hereinafter "Mead"). Applicant respectfully traverses the Examiner's rejection under both 35 U.S.C. § 102 and 103.

Regarding Claim Rejections Under 35 U.S.C. § 102

Applicant respectfully traverses the Examiner's rejection of claims 1-4 and 7-10 under 35 U.S.C. § 102(e) as anticipated by Benear. In order to anticipate Applicant's claimed invention under 35 U.S.C. § 102, each and every element of the claim in issue must be found, either expressly described or under principles of inherency, in a single prior art reference. Further, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." See M.P.E.P. § 2131, quoting Richardson v. Suzuki Motor Co., 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Claim 1, as amended, recites a combination including, for example, "a display device which displays resolution and image quality information after recompression." Benear fails to disclose at least "a display device which displays resolution and image quality information after recompression," as required by amended claim 1.

Benear teaches an apparatus "for writing compressed data to a storage device having multiple storage areas." Benear, abstract. The apparatus in Benear includes a compressor 24 that "operates to write, according to the principles of the present

invention, the compressed video to the disk drive unit 20,” where “a particular cylinder is assigned a minimum compression ratio. . . .” Benear, column 4, lines 43-56.

Specifically, “the compressor 24 first compresses the video data and calculates the compression ratio (step 70). Next, the compressor 24 operates to use the compression ratio to identify a cylinder in the disk drive unit 20 (step 72) to receive the compressed video data.” Benear, column 5, lines 3-8, emphasis added. However, Benear does not disclose “a display device which displays resolution and image quality information after recompression,” as required by claim 1.

The Examiner alleged that Benear discloses “a writing device (corresponding to compressor 24) configured to write the set compression ratio as additional data for the stored digital data to storage device 20 (Fig. 1).” (Office Action at 2.) Applicant respectfully disagrees. Benear’s teaching of identifying a disk cylinder using calculated compression ratio does not constitute a teaching of “a writing device configured to write the set compression ratio as one item of additional data for the stored digital data to said storage device,” as recited by claim 1 (emphasis added).

Thus, Benear fails to teach each and every element of amended claim 1. Applicant respectfully requests withdrawal of the rejection of claim 1. Because claims 2-4 depend from claim 1, Applicant also requests withdrawal of the rejection of claims 2-4 for at least the same reasons stated above.

Independent claim 7, while of different scope, recites similar language to that of claim 1. Claim 7 is therefore also allowable for at least the same reasons stated above. Applicant respectfully requests withdrawal of the rejection of claim 7 and its dependent claims 8-10.

Regarding Claim Rejections Under 35 U.S.C. § 103

Applicant respectfully traverses the Examiner's rejection of claims 5, 6, 11, and 12 under 35 U.S.C. § 103(a) as unpatentable over Benear in view of Mead. In order to establish a prima facie case of obviousness, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim elements. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Third, there must be a reasonable expectation of success. See M.P.E.P. § 2143.

Claims 5 and 6 depend from claim 1. As explained above, Benear fails to teach or suggest at least "a display device which displays resolution and image quality information after recompression," as required by claim 1.

Mead fails to cure Benear's deficiencies. Mead discloses a two-stage video film compression device. "More specifically, the first coder stage employs a predictive coder 24 to compress the data to form the intermediate representation." Mead, column 3, lines 60-63. "A second coder stage 28, which acts as a recorder, is coupled to the digital storage device 22." Mead, column 4, lines 6-9. However, Mead fails to teach or suggest "a display device which displays resolution and image quality information after recompression," as required by claim 1.

Therefore, neither Benear nor Mead, taken alone or in any reasonable combination, teaches or suggests all the elements of Applicant's invention as recited in amended claim 1. No prima facie case of obviousness has been established, and claim 1 thus is nonobvious over Benear in view of Mead. Because claims 5 and 6 depend

from claim 1, Applicant respectfully requests withdrawal of the rejection of claims 5 and 6 for at least the reasons stated above.

Further, independent claim 7, while of different scope, recites similar language to that of claim 1. Claim 7 is therefore also nonobvious over Benear in view of Mead. Because claims 11 and 12 depend from claim 7, Applicant also requests withdrawal of the rejection of claims 11 and 12 for at least the same reasons stated above.

Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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